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10/035,202	01/04/2002	Roger Spink	016790-0444	3477

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EXAMINER

FINEMAN, LEE A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,202

Applicant(s)

SPINK ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-10, 13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species I in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant has stated the claims 1 and 11 are generic. However, as all the species do not include a rotating shutter, these claims will not be considered generic.

Finally, although the applicant has not included claims 4 and 5 in the election, the examiner believes these claims also read on the elected species and will be examined on the merits.

2. Claims 6-10, 13 and 15-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "2L," "L," "d1," "d2," "R".

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "30" has been used to designate both lenses in fig. 2 and lamellar mirror in

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fig. 10; and reference character “17” has been used to designate both a light source in fig. 20 and a direction in fig. 15.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “50b” in fig. 27.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 12, which is dependent on claim 11, has the limitations “a second beam splitter disposed in the first beam path and a third beam splitter disposed in the second beam path.” The specification and drawings do not describe an embodiment wherein the first and second beam paths are geometrically superimposable with a third beam path as well as a display to provide

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image information to the first and second beam paths **and** a second beam splitter disposed in the first beam path and a third beam splitter disposed in the second beam path. Figs. 13, 15, 18, 24, 27, and 28 include a display. Of those figures, figs. 13, 15, and 18 do not have a second and third beam splitter and figs. 18, 24, and 27 do not have a first and second beam path superimposable on a single third beam path with the display image going to both the first and second beam paths. Dependent claim 14 inherits the deficiencies of the claims from which it depends.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Beste, U.S. Patent No. 3,251,933.

Regarding claim 1, Beste discloses a stereoscopic system (fig. 1) comprising a first beam path (R) and a second beam path (L); a beam splitter (42) disposed in the first and second beam paths (fig. 1) wherein the two beam paths are geometrically superimposable with a third beam path (44); and a non-reflective, rotating shutter (34 or 36) wherein said shutter comprises at least one aperture diaphragm (fig. 3) for alternately making a given first or second beam path passable by light or blocking said given first or second beam path in a light-tight manner (fig. 1). The preamble fails to structurally limit the body of claim. Beste meets all of the structural limitations

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required by the claim in support thereof. As such, Beste must support a stereomicroscope in the same way as the structure of the claim.

Regarding claim 3, Beste further disclose a first deflecting mirror (28) disposed in the first beam path; and a second deflecting mirror (26) in the second beam path, wherein the first and second beam paths are superimposable at a location proximate to a position of the beam splitter (fig. 1).

Regarding claim 4, Beste further discloses an image recording device (11) disposed in the third beam path (44); and a shutter motor (40) to drive said rotating shutter.

Regarding claim 5, Beste further discloses wherein the shutter motor is driven in synchronization with a reading of the image-recording device (column 2, lines 58-62).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beste in view of Kato et al., U.S. Patent No. 4,827,909.

Beste discloses the claimed invention except for the non-reflective rotating shutter having a plurality of opaque and transmissive regions, wherein the rotation speed of the shutter is reduceable. Kato et al. teach a stereoscopic microscope (fig. 5) with a single non-reflective rotating shutter (fig. 6) in both beam paths and having a plurality of opaque (L2) and

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transmissive regions (L1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the two rotating shutters of Beste with the single shutter of Kato et al. to reduce the number of parts and save money. Further, the rotation speed would be reduced to keep the same timing interval between images.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martino et al., U.S. Patent No. 5,307,202 in view of Rossire, U.S. Patent No. 3,614,314 or Perisic, U.S. Patent No. 4,678,298.

Regarding claim 11, Martino et al. disclose a stereomicroscope (fig. 1) comprising a first beam path (to the right eye) and a second beam path (to the left eye); a beam splitter (5) disposed in the first and second beam paths (fig. 1) wherein the two beam paths are geometrically superimposable with a third beam path (6a); a display (11) to provide image information to the first and second beam paths (fig. 1) and a sliding mirror (13) alternatively making a given first or second beam path passable by light or blocking said given first or second beam path in a light-tight manner. Martino et al. disclose the claimed invention except for a rotating shutter, wherein said shutter comprises at least one aperture diaphragm for alternately making a given first or second beam path passable by light or blocking said given first or second beam path in a light-tight manner. Rotating shutters are well known in the art for selecting an optical path for all the incident light. For example, both Rossire and Perisic have rotatable shutters (25, fig. 2, Rossire and 8, fig. 1, Perisic) with at least one aperture (33, 35 or 37, Rossire and fig. 1a, Perisic), which select an optical path for the incident light. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use well-known rotatable shutters

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in place of the sliding mirror of Martino et al. since rotating and sliding motions are art recognized equivalent manners in which to locate elements in a beam path. Further, a rotating arrangement would typically be a less complicated method of providing consistent switching of the optical path.

Regarding claim 12, Martino et al. further disclose left and right eyepieces (7) and wherein the image information from the display (11) is viewed by an observer (8) through the eyepieces (fig. 1). Martino et al. disclose the claimed invention except for a second beam splitter disposed in the first beam path and a third beam splitter disposed in the second beam path. Official Notice is taken that beam splitters are well known in the art for redirecting portions of light into different beam paths. It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert a beam splitter into the first and second beam paths in order for another viewer to see the object or another detector/camera to record it.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martino et al. in view of Rossire or Perisic as applied to claim 12 above, and further in view of Minns et al., U.S. Patent No. 3,353,892.

Martino et al. in view of Rossire or Perisic as applied to claim 12 above disclose the claimed invention except for a first prism disposed in the first beam path; and a second prism in the second beam path wherein the prisms guide the image information into respective eyepieces. Prisms are well known in the art for guiding optical image information. For example, Minns et al. teach a stereoscopic microscope (fig. 1 and 2) with a prism (7) for guiding optical image information to the eyepieces (10). Therefore it would have been obvious to one of ordinary skill

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in the art at the time the invention was made to use well-known prisms in the system of Martino et al. in view of Rossire or Perisic to guide optical image information to the eyepieces.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato et al., Japanese Patent Application No. JP03223807A, disclose a video superimposing type stereomicroscope.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF
June 2, 2003


MARK A. ROBINSON
PRIMARY EXAMINER